



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/943,776	10/03/1997	MARIAPIA A. DEGLI-ESPOSTI	2849-A	9687

22932 7590 01/09/2006

IMMUNEX CORPORATION
LAW DEPARTMENT
1201 AMGEN COURT WEST
SEATTLE, WA 98119

EXAMINER

SPECTOR, LORRAINE

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/943,776

Applicant(s)

DEGLI-ESPOSTI ET AL.

Examiner

Lorraine Spector, Ph.D.

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,10,13,16,20,21,23,24,27-29 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-42 is/are allowed.
- 6) ☒ Claim(s) 1,6,10,13,16,23,24,27-29,31,32 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,6,10,13,16,20,21,23,24,27-29 and 31-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/2005 has been entered.

Claims 1,6,10,13,16,20,21,23,24,27-29 and 31-43 are pending.

Claims 1,6,10,13,16,23,24,27-29 and 31-43 are under consideration.

Rejections Over Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23, 24, 27, 28, 31-32, and 43 remain rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al., U.S. Patent Number 6,153,402, for reasons of record in the previous Office Action, paper number 13, as well as in the paper mailed 2/10/2005.

Applicant's traversal in the paper filed 10/11/2005 has been fully considered but is not deemed persuasive. Applicants argue that the isolated polypeptides recited in claims 223 and 31 are not found in the '402 priority document, since they are not identical to DR3-VI. This argument has been fully considered but is not deemed persuasive because Yu's protein is 98% identical to SEQ ID NO: 2 at residues 1-417. Claim 23 encompasses 'polypeptides

comprising'...'fragments of the polypeptides' that comprise amino acids x1 to x2 of SEQ ID NO: 2, wherein said fragments are capable of inhibiting apoptosis. Since Yu's SEQ ID NO: 2, which merits priority to the filing date of Provisional Application 30/013285, filed 3/12/96, is 98% identical to residues 1-417 of SEQ ID NO: 2, and 100% identical to residues 14-417 of SEQ ID NO: 2, it "comprises" amino acids x1-x2 of SEQ ID NO: wherein x1 is 14 and x2 is any one of amino acids 190-200. As the protein is further disclosed by Yu to induce apoptosis, it meets the limitations of claim 23. With respect to claim 31, clearly Yu's SEQ ID NO: 2 has an extracellular domain comprising a fragment of amino acid residues 1-199 of SEQ ID NO: 2 of the instant application, and the fragment is disclosed to induce apoptosis. With respect to claim 43, SEQ ID NO: 2 of Yu comprises numerous amino acid sequences that are at least 70% identical to SEQ ID NO: 6, and is disclosed as being capable of inducing apoptosis. Deletion of the phrase "comprising an amino acid sequence" from claim 43 would obviate this rejection with respect to that claim.

Claims 1, 6, 10, 13, 16, 23, 24, 27-29, 32, 32 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,462,176 and US Patent Application Publication US2002/0192729 A1 (Ashkenazi-1 and -2), both cited by applicants. This rejection is maintained for reasons of record. Applicants arguments have been fully considered but are not deemed persuasive for reasons cited above. It is not required that Ashkenazi have disclosed the instant SEQ ID NO: 6 to anticipate the rejected claims.

Applicants are advised that in order to provoke an interference, new rules apply. See MPEP 2300.

Conclusion

Claims 33-42 are allowable.

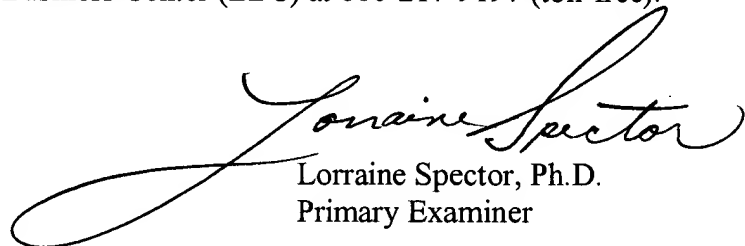
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 3:00 P.M. at telephone number 571-272-0893.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's supervisor, Ms. Brenda Brumback, at telephone number 571-272-0961.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to 571-273-8300. Faxed draft or informal communications with the examiner should be directed to **571-273-0893**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lorraine Spector, Ph.D.
Primary Examiner